

(2) Remarks

The Examiner has required applicant to elect between:

- I. claims 1 to 4 and 13 to 16 drawn to a coating process, classified in class 427, subclass 256;
- II. Claims 5 to 8, said to be drawn to a kit, classified in class 15, subclass 257; and
- III. Claims 9 to 12, said to be drawn to a composition, classified in class 106, subclass 400

Applicant elects the method claims of Group I, with traverse.

Applicant will maintain all of the claims in the application until allowable subject matter is indicated, at which time the examiner is requested to reconsider the restriction and withdraw it if it has not been withdrawn by that time.

Applicant traverses the restriction requirement because the claim wording links them by their very terms; and, as a practical matter, there is simply no way to search the claims of either of the groups -- thoroughly -- without searching for the other.

A careful reading of the description of the invention, including the Background of The Invention and Summary of the Invention sections, will make it clear that the invention solves a real prior art problem and that the method utilizes the kit to solve the problems. The claims of the two groups as listed in the Office Action are interrelated, not separate and distinct.

All of the claims should be grouped together because they include “a community of properties justifying their grouping which [is] not repugnant to principles of scientific classification” [*In re Harnish*, 631 F.2d 716, 206 U.S.P.Q. 300, 305, (C.C.P.A. 1980)]. The claims of Group I relate to a “process for imparting a wood grain to a textured surface having a pattern of texture surfaces with recesses therein, comprising: applying an opaque, pigmented, water-based paint/stain emulsion to a wood-grain textured substrate; drying the paint/stain emulsion; sparingly applying a pigmented, water-based graining coat in an amount sufficient to

color at least a majority of texture recesses in the substrate; and air drying the graining coat.” This is what the title of the invention calls for and is cooperative with the kit claimed Group II. One group of claims cannot be examined without searching for the other.

Importantly, an applicant has a “right to define what he regards as his invention as he chooses, so long as his definition is distinct” *[ibid.]*. And, “[a]s a general proposition, an applicant has a right to have each claim examined on the merits” *[In re Weber, Soden and Boksay, 580 F.2d 455, 198 U.S.P.Q. 328, 331 (C.C.P.A. 1978)]*. That court and its successor have long recognized the advantages to the public interest in permitting applicants to claim all aspects of the invention so as to encourage the making of a more detailed disclosure of all aspects of the discovery.

We believe the constitutional purpose of the patent system is promoted by encouraging applicants to claim, and therefore to describe in the manner required by 35 U.S.C. § 112, all aspects of what they regard as their inventions, regardless of the number of statutory classes involved.

In re Kuehl, 177 U.S.P.Q. 250, 256 (C.C.P.A. 1973).

Since it is the case that the claims all relate to a wood graining kit and process of using it to provide a wood grained surface, searching the subject matter of one classification with that of others is the only way to yield ALL references pertinent to the invention; and, accordingly, there is no increased, much less undue, burden for examination purposes. Even though the Patent Office classification system may indicate different places to list the patents after complete examination and allowance, there is a central theme and necessary technical relationship which links the process, kit and composition.

Applicants note that the current search method does not require looking in the different shoes, so whatever justification previously attached to the burden of going from location to location in the Patent Office, no longer exists.

The requirement puts form over substance, utilizing an arcane classification procedure – unlike the unity of invention standard accepted internationally – to segment the invention disclosure into differently-classifiable parts.

It must be recalled that the classification system is made for the convenience of filing and retrieving documents. It is not a fair use of the classification system to say that it provides a correct standard by which the number of inventions in an application is to be determined. Such a determination must be based on the actual description in the application and a comparison of that to what is described in the prior art.

Requiring applicants to pay filing fees, prosecution costs, issue fees, and maintenance fees for several patents for one invention is an undue burden for applicant in the first instance and the public on a continuing basis.

Accordingly, reconsideration and withdrawal of the requirement for restriction are believed in order and are requested. In the alternative, the examiner is requested to reconsider the restriction and withdraw it once allowable subject matter is indicated if it has not been withdrawn by that time.

Respectfully submitted,

A handwritten signature in cursive script, appearing to read "Thaddius J. Carvis", written over a horizontal line.

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